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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,120	03/29/2001	Dwip N. Banerjee	AUS9-2000-0927-US1	3269

7590

05/17/2005

International Business Machines Corporation
Intellectual Property Law Department
Internal Zip 4054
11400 Burnet Road
Austin, TX 78758

EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,120

Applicant(s)

BANERJEE ET AL.

Examiner

Prieto Beatriz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to: See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Application No. 09/821,120 filed 12/17/04, claims 1, 7 and 13 have been amended, claims 1-18 remain pending and have been examined.
2. Acknowledge is made to applicant's statement under 37 C.F.R. Section 1.97(b) filed 03/29/01. Examiner accepts drawings for the purposes of examination. No claim priority is noted.

Claim Rejection under 35 U.S.C. 102

3. Quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action may be found in previous office action.
4. Claims 1-3, 7-9 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by LIM et. al. U.S. Patent No. 5,884,024 (Lim hereafter).

Regarding claims 1-3, 7 and 13, Lim teaches a system of Fig. 1, including a computer network (100) with user access for communicating with a plurality of server (108) of said network (col 5/line 27) via a client computer station (102) controlled by a plurality of data processor (col 3/lines 46-53), the system comprising:

a service provider means (106-110) supporting a set of said clients (col 2/lines 48-51), the service provider means including:

means (110) responsive to a query request from a client computer station for assigning and sending an IP address to the requesting client computer station (means 110: col 5/lines 10-25, query request: col 5/lines 27-30, 38-48 and 400 of Fig. 4, assigning col 1/lines 65-col 2/lines 3 and col 3/lines 54-col 4/line 2);

means (106) for sending each said query request to a server (col 2/line 22-24, col 6/lines 15-23, step 702 of Fig. 7, col 7/lines 23-30);

a server (110) means (316) responsive to accessing a response to each query for request (steps 702-716 of Fig. 7), determining if said assigned IP address is still assigned to said requesting client computer station (step 720 of Fig. 7) (col 3/lines 28-39, col 6/lines 55-col 7/line 6, 12-20); and

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means (110) for sending (steps 720 or 732) said accessed query response (steps 716-720 of Fig. 7) to said requesting client computer station only if said IP address is still assigned to said requesting client computer station by means of the corresponding IP lease (col 3/lines 28-39, col 6/lines 12-15 and col 7/lines 58-67).

Regarding claim 2, wherein the assignment is for only as long as the one particular requesting client computer station continues to renew his/her IP address lease via corresponding query request (col 7/lines 40-42).

Regarding claim 3, means enabling the dynamic reassigning of an IP address to another requesting client station upon the discontinuance of a periodic query request from one requesting client station (col 6/lines 28-34).

Regarding method claims 8 and 9 these claims are substantially the same as the system claims 2 and 3 discussed above, same rationale of rejection is applicable.

Regarding the computer implementation claims 14 and 15 these claims are substantially the same as the system claims 2 and 3 same rationale of rejection is applicable.

Claim Rejection under 35 U.S.C 103

5. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

6. Claims 4-6, 10-12 and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over LIM in view of RODWIN et. al. U.S. Patent No. 5,812,819 (Rodwin).

Regarding claim 4, however Lim does not explicitly teach where the client computer station is an wireless mobile device.

Rodwin teaches a system/method with the field of endeavor of instant application (col 1/lines 5-14). including a client computer station such as a wireless mobile device (col 1/lines 36-39) for accessing a computer network including a service access provider supporting said wireless mobile device (col 1/lines

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48-57), wherein said service access provider includes a server for dynamically assigning IP addresses to requesting client stations (col 1/lines 58-col 2/lines 9).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Lim's teachings for assigning an IP address already assigned to another client, suggesting that the client system may be selected from a range of differing device operable in other networking technologies and topologies other than discussed. One ordinary skilled in the art would be motivated to combine the teachings of the Lim and Rodwin references enabling the assignment of the same IP address to the requesting client even if the client's communication was interrupted and the client is subsequently using a different device for accessing the network, as taught by Rodwin.

Regarding claim 5, means for receiving a wireless query request from said mobile station within a limited range of transmission distance; and wherein said mobile station is enabled to move out of said limited range to thereby discontinue said query request.

Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art) is taken that wireless communication device can only communicate with other device when within a limited range of transmission distance was old and well known in the Data Processing art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include this because moving stations typically loose contact with the base or relay station because of interruptions of communication caused by obstacles and movement of the communication device outside a wireless distance range base on associated transceiver capabilities (e.g. Ref A-B).

Regarding claim 6, database means (316) for recording the IP addresses dynamically assigned to client stations (Lim: col 6/lines 45-54 and col 7/lines 12-20) used for determining if said assigned address is still assigned access to said database (Lim: col 3/lines 28-39, col 6/lines 55-col 7/line 6).

Regarding method claims 10-12, these claims are substantially the same as the system claims 4-6 discussed above, same rationale of rejection is applicable.

Regarding the computer implementation claims 16-18, these claims are substantially the same as the system claims 4-6, same rationale of rejection is applicable.

Response to arguments

7. Regarding claims 1-3, 7-9 and 13-15 are rejected under 35 U.S.C. 102 as being anticipated by Lim, it is argued (remarks on p. 8) that the reference is not interested in the dynamics or problems associated with individual web query requests.

In response to the above-mentioned argument, that the alleged anticipatory prior art is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). >See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (The question of whether a reference is analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.) (see MPEP 2131.05).

8. Regarding claims 1-3, 7-9 and 13-15 are rejected under 35 U.S.C. 102 as being anticipated by Lim, it is argued (remarks on p. 11) that the reference does not hint the problem of reassignment of IP addresses when the requesting wireless mobile device moves out of transmission range.

In response to the above-mentioned argument, same rationale set forth in response to argument on item 8, is applicable.

9. Regarding claims 1-3, 7-9 and 13-15 are rejected under 35 U.S.C. 102 as being anticipated by Lim, it is argued (remarks on p. 9), that the reference does not teach where the determination step is performed in response to a "query request".

In response to the above-mentioned argument, it is noted that applicant is entitled to be his/her own lexicographer, however, claims are given the broadest reasonable interpretation in light of the specification, in this case, the claim term "query request" has been broadly interpreted as a request and a "query response" has been interpreted as a response or results associated with said request.

In this case, Lim teaches a "web" server (110) means (316) responsive to accessing a "response" (710-716, e.g. searching/obtaining the result to the search, i.e. "accessing a response") to each "query" request (i.e. request 702) received, the step (720) for determining if said assigned IP address is still

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assigned to said requesting client station (e.g. lease has not expired) (col 7/lines 21-col 8/line 55); and means (110) for sending (steps 720 or 732) said accessed "query" response (steps 716-720 of Fig. 7) to said requesting client computer station only if said IP address is still assigned to said requesting client computer station by means of the corresponding IP lease (col 7/lines 58-67).

10. Applicant's arguments filed 12/17/04 have been fully considered but not rendered persuasive.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

B. Prieto
TC 2100
Primary Examiner
May 13, 2005

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER